

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

OMEGA PATENTS, LLC,)
)
Plaintiff,)
)
v.) C.A. No. 21-030-CFC
)
BAYERISCHE MOTOREN WERKE)
AG AND BMW OF NORTH)
AMERICA, LLC,)
)
Defendants.)

**STIPULATION AND ORDER TO STAY
PENDING *INTER PARTES* REVIEW**

WHEREAS, plaintiff Omega Patents, LLC (“Omega”) has accused defendants BMW of North America, LLC (“BMW NA”) and Defendant Bayerische Motoren Werke AG (“BMW AG”) of infringing certain claims of U.S. Patent No. 9,458,814 (the “’814 Patent”) (D.I. 1 at 8-10);

WHEREAS, Defendant BMW AG has not been served, has not entered an appearance and has not waived its right to contest sufficiency of process and service of process (if/when effected), lack of personal jurisdiction, and any other such arguments as it may deem appropriate;

WHEREAS, on May 10, 2021, the Patent Trial and Appeal Board (“PTAB”) instituted an *inter partes* review proceeding on all claims of the ’814 Patent (IPR2021-00181);

WHEREAS, the PTAB's final written decision on the IPR is due by May 10, 2022 (37 C.F.R. § 42.100(c));

WHEREAS, the final written decision by the PTAB may simplify a substantial portion of this case, especially in connection with dispositive motions and trial, and may reduce or eliminate claims or defenses being litigated;

WHEREAS, this case is at an early stage, and the Court has not yet scheduled a case management conference or issued a scheduling order in this action;

NOW, THEREFORE, IT IS STIPULATED AND AGREED, by and between Omega and BMW NA, through their undersigned counsel, and subject to the approval of the Court, as follows:

1. This Action shall be stayed as to all parties pending the PTAB's final written decision as to the patentability of the asserted claims of the '814 Patent in IPR2021-00181, or an order terminating the proceeding prior to a final written decision.

2. While the stay is pending, Omega may continue its efforts to serve BMW AG. The case will otherwise remain stayed while it does so. Upon any service of BMW AG, BMW AG's deadline to answer, move, or otherwise respond to the complaint shall be suspended. If the Court lifts the stay of the action upon resolution of the IPR, BMW AG's deadline to answer, move, or otherwise respond to the complaint shall be calculated as if BMW AG were first served on the date that

the Court lifts the stay.

3. The parties shall file a joint status report with the Court within 14 days of the date on which the PTAB's final written decision or termination order is issued.

/s/ Ronald P. Golden, III

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Dated: June 3, 2021

SO ORDERED this 7th day of June, 2021.



United States District Judge